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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,697	01/10/2001	David Stephen Gress	95-456	4607

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EXAMINER	
OSMAN, RAMY M	
ART UNIT	**PAPER NUMBER**
2157	

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/756,697	GRESS ET AL.	
	Examiner	Art Unit	
	Ramy M Osman	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-78* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-78* is/are rejected.

7)☒ Claim(s) *5* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 January 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because figures 2-4 are not legible. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Formal drawings are required for figures 2-4.

Claim Objections

2. Claim 5 objected to because of the following informalities: On line 2 put the format extension .wav into quotation marks: ".wav". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1,37 and 58 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation of "to leave a message" is unclear and does not explicitly describe as to where the message is being "left", and whether the message is being left on an external server, the users computer or a destination computer etc..

5. Claims 1,8,11,22,30,37,44,47,58,65 and 68 rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The limitation "receiving a request for a user interface session to enable.." is unclear. Is the user interface being requested so it can be transferred to the user to enable the user to leave a message. Or is the user interface on the user computer and it establishes a session. Or is the request requesting the establishment of a user interface session on the server to enable a remote user to "leave a message".

6. Claims 9,45 and 66 rejected under 35 U.S.C. 112, second paragraph, as being indefinite. It is not clear how data can be decrypted if the keys do not match. The claim language seems to

imply that the data will be output while it is still encrypted because the keys do not match, while it contradictly states that the data will be decrypted.

7. Claims 22 and 30 rejected under 35 U.S.C. 112, second paragraph, as being indefinite. It is not whether the limitation "an IP-based interface" is the same as the "user interface session".

8. Claims 8,44 and 65 recites the limitation "stored messages" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1,2,7-15,18,20,22,23,26-32,35-38,43-50,54,56,58,59,62,64-71,73,75 and 77 rejected under 35 U.S.C. 103(a) as being unpatentable over Olkin et al. (U.S. Patent No. 6,584,564) in view of Lee et al. (U.S. Patent No. 6,661,877).

3. In reference to claims 1,2,22,23,26,30,31,35,37,38,58 and 59, Olkin teaches a method in a secure e-mail system (Abstract and column 1 lines 5-10) comprising:

Receiving a request for a user interface session to enable a user to leave a message for an identified destination subscriber (column 3 line 30 – column 4 line 25, column 6 lines 23-67,

column 11 lines 35-67 and column 12 lines 20-56, Olkin discloses an interface session for a user to leave a message by sending it to an identified destination address);

Generating a first prompt enabling the user to select encryption of the message (column 3 line 30 – column 4 line 25, column 6 lines 23-67, column 11 lines 35-67 and column 12 lines 20-56, Olkin discloses a first "send securely" prompt enabling the user to encrypt the email);

Generating a second prompt, based on the user selecting encryption of the message for the user to supply an encryption key (column 3 line 30 – column 4 line 25, column 6 lines 23-67, column 11 lines 35-67 and column 12 lines 20-56, Olkin discloses a second prompt for the user to supply an encryption MessageKey, via entering a password);

Causing encryption of the message into an encrypted message based on the encryption key supplied by the user (column 3 line 30 – column 4 line 25, column 6 lines 23-67, column 11 lines 35-67 and column 12 lines 20-56, Olkin discloses encrypting the email based on the key); and

Outputting the encrypted message to a determined destination based on determined subscriber profile attributes for the identified destination subscriber (column 3 line 30 – column 4 line 25, column 6 lines 23-67, column 11 lines 35-67, column 12 lines 20-56 and column 14 lines 23-45, Olkin discloses sending the encrypted email to the determined destination address).

Olkin fails to explicitly teach the secure email system as a unified communications system. However, Lee teaches message exchange integration for a unified messaging system providing access to stored messages on the messaging systems through a web based user

interface, in order to accommodate the modern age of divergent electronic communications (Abstract, column 1 lines 14-56, column 2 lines 54-67 and column 3 lines 55-67).

It would have been obvious for one of ordinary skill in the art to modify the email system of Olkin by integrating other messaging systems for a unified messaging system providing access to the messaging systems through a web based user interface as per the teachings of Lee so as to accommodate the modern age of divergent electronic communications.

4. In reference to claim 7,43 and 64, Olkin in view of Lee teach claim 1 above. Olkin fails to explicitly teach outputting the encrypted message to the determined destination according to at least one of SMTP protocol and IMAP protocol. However, Lee teaches that it is well known to implement message communication with SMTP or IMAP4 (column 4 lines 1-20).

It would have been obvious for one of ordinary skill in the art to make the email system of Olkin send messages according to SMTP as per the teachings of Lee because it is the standard TCP/IP protocol used for sending messages over the Internet.

5. In reference to claim 8,27,44 and 65, Olkin in view of Lee teach claim 1 above. Olkin further teaches

Receiving a request for a second user interface session to enable the identified destination subscriber to retrieve stored messages (column 15 lines 1-15 & 30-67 and column 16 lines 43-67, Olkin discloses a second user interface session on a receivers browser);

Retrieving information related to the stored messages for the identified destination subscriber (column 15 lines 1-15 & 30-67 and column 16 lines 43-67, Olkin discloses message summary information on the receivers browser, which means it is inherently retrieved);

Detecting one of the stored messages as encrypted (column 15 lines 1-15 & 30-45, Olkin discloses identifying a selected message as encrypted);

Generating a third prompt, based on detecting the one stored message, for the identified destination subscriber to supply a decryption key (column 15 lines 1-15 & 30-67 and column 16 lines 25-67, Olkin discloses a third prompt for the receiver to supply a decryption process with a MessageKey, via entering a password); and

Supplying the decryption key and the one stored message to an invoked decryption utility for decryption of the one stored message into a decrypted data file (column 15 lines 1-15 & 30-67 and column 16 lines 25-67, Olkin discloses decrypting the message based on the key).

Olkin fails to explicitly teach the secure email system as a unified communications system. However, Lee teaches message exchange integration for a unified messaging system providing access to stored messages on the messaging systems through a web based user interface, in order to accommodate the modern age of divergent electronic communications (Abstract, column 1 lines 14-56, column 2 lines 54-67 and column 3 lines 55-67).

It would have been obvious for one of ordinary skill in the art to modify the email system of Olkin by integrating other messaging systems for a unified messaging system providing access to the messaging systems through a web based user interface as per the teachings of Lee so as to accommodate the modern age of divergent electronic communications.

6. In reference to claim 9,28,45 and 66, Olkin in view of Lee teach claim 1 above. Olkin further teaches outputting the decrypted data file during the second user interface session to the

identified destination subscriber, independent of the encryption key matching the decryption key (column 16 lines 10-25, Olkin discloses independent of the receiver password not matching for decrypting the message, the message will be displayed as unintelligible gibberish in the body).

7. In reference to claim 10,29,36,46 and 67, Olkin in view of Lee teach claim 1 above. Olkin further teaches wherein the receiving step includes receiving the request according to hypertext transport protocol (column 6 lines 45-60, column 13 lines 5-53 and column 16 lines 60-67, Olkin discloses transmission according to secure HTTP).

9. In reference to claims 11,12,14,47,48,50,68,69 and 71 Olkin teaches a method in a secure e-mail system (Abstract and column 1 lines 5-10) comprising:

receiving a request for a user interface session to enable a messaging subscriber to retrieve stored messages (column 15 lines 1-15 & 30-67 and column 16 lines 43-67, Olkin discloses a second user interface session on a receivers browser);

accessing subscriber profile information from a subscriber profile directory according to a prescribed open network protocol (column 15 lines 1-15 & 30-67 and column 16 lines 43-67, Olkin discloses message summary information on the receivers browser, which means it is inherently retrieved);

determining one of the stored messages is encrypted based on access of a message store according to a prescribed open network protocol and based on the accessed subscriber profile information (column 15 lines 1-15 & 30-45, Olkin discloses identifying a selected message as encrypted);

generating a prompt, based on identifying the one stored message as encrypted, for the messaging subscriber to supply a decryption key (column 15 lines 1-15 & 30-67 and column 16 lines 25-67, Olkin discloses a prompt for the receiver to supply a decryption process with a MessageKey, via entering a password); and

attempting decrypting of the one stored message based on the decryption key supplied by the messaging subscriber (column 15 lines 1-15 & 30-67 and column 16 lines 25-67, Olkin discloses decrypting the message based on the key).

Olkin fails to explicitly teach the secure email system as a unified communications system. However, Lee teaches message exchange integration for a unified messaging system providing access to stored messages on the messaging systems through a web based user interface, in order to accommodate the modern age of divergent electronic communications (Abstract, column 1 lines 14-56, column 2 lines 54-67 and column 3 lines 55-67).

It would have been obvious for one of ordinary skill in the art to modify the email system of Olkin by integrating other messaging systems for a unified messaging system providing access to the messaging systems through a web based user interface as per the teachings of Lee so as to accommodate the modern age of divergent electronic communications.

10. In reference to claim 13,32,49 and 70, Olkin teaches the method of claim 12 above wherein the outputting step includes outputting the decryption result independent of whether the decryption key enabled successful decryption of the one stored message (column 16 lines 10-25, Olkin discloses independent of the receiver password not matching for decrypting the message, the message will be displayed as unintelligible gibberish in the body).

11. In reference to claim 16,52 and 73, Olkin in view of Lee teach claim 11 above. Olkin further teaches wherein the receiving step includes receiving the request according to hypertext transport protocol (column 6 lines 45-60, column 13 lines 5-53 and column 16 lines 60-67, Olkin discloses transmission according to secure HTTP).

8. In reference to claim 18,20,54,56,75 and 77, Olkin in view of Lee teach claim 1 above. Olkin fails to explicitly teach outputting the encrypted message to the determined destination according to at least one of SMTP protocol and IMAP protocol. However, Lee teaches that it is well known to implement message communication with SMTP or IMAP4 (column 4 lines 1-20).

It would have been obvious for one of ordinary skill in the art to make the email system of Olkin send messages according to IMAP as per the teachings of Lee because it is the standard TCP/IP protocol used for sending messages over the Internet.

9. Claims 3-5,15,19,21,39-41,51,55,57,60-62,72,76 and 78 rejected under 35 U.S.C. 103(a) as being unpatentable over Olkin et al. (U.S. Patent No. 6,584,564) in view of Lee et al. (U.S. Patent No. 6,661,877) in further view of Montville et al. (U.S. Patent No. 6,356,937).

10. In reference to claim 3,24,33,39 and 60, Olkin in view of Lee teaches the above mentioned claims. Olkin fails to explicitly teach a Multipurpose Internet Mail Extension (MIME) that specifies a format of the message, the causing encryption step including encrypting the message data file into an encrypted file having a MIME extension specifying that the

encrypted file has an encrypted format. Lee only teaches MIME compliance (column 4 lines 40-60). However, Montville teaches a secure email system compliant with the SMIME protocol which provides extensions specifying the format of a message, including an encrypted format of a message (column 3 and column 8 line 45 – column 9 line 20).

It would have been obvious for one of ordinary skill in the art to modify Olkin by having a MIME extension specifying the format of a message as per the teachings of Montville to comply with a standard in secure messaging in identifying different kinds of data files.

11. In reference to claim 4,40 and 61, Olkin in view of Lee in further view of Montville teach claim 3 above. Olkin teaches generating a message transport header specifying an IP based destination address corresponding to the identified destination subscriber (column 6 and column 7 lines 25-55, Olkin discloses specifying a destination address).

12. In reference to claim 5,41 and 62, Olkin in view of Lee in further view of Montville teach claim 3 above. Olkin fails to explicitly teach wherein the message data file has a MIME extension specifying a .wav format, the message having an audio header and audio payload, the causing encryption step including encrypting the audio header and the payload within the encrypted file. However Lee teaches MIME message files having WAV format, with a header and body (column 6 lines 1-20, column 7 line 55 – column 8 line 30 and column 10 line 60 – column 11 line 42).

It would have been obvious for one of ordinary skill in the art to modify Olkin by having a MIME extension specifying a WAV format of a message as per the teachings of Lee where Olkin would encrypt the header and body to comply with a standard in secure messaging in different kinds of data files, specifically audio WAV files.

12. In reference to claims 15,19,21,51,55,57,72,76 and 78, Olkin teaches method of claim 11 above. Olkin fails to explicitly teach wherein it further comprises obtaining, based on the attempting decrypting step, a decryption result including a message data file having a message and a Multipurpose Internet Mail Extension (MIME) that specifies a format of the message Lee only teaches MIME compliance (column 4 lines 40-60). However, Montville teaches a secure email system compliant with the SMIME protocol which provides extensions specifying the format of a message, including an encrypted format of a message (column 3 and column 8 line 45 – column 9 line 20).

It would have been obvious for one of ordinary skill in the art to modify Olkin by having a MIME extension specifying the format of a message as per the teachings of Montville to comply with a standard in secure messaging in identifying different kinds of data files.

13. Claim 6,17,25,34,42,53,63 and 74 rejected under 35 U.S.C. 103(a) as being unpatentable over Olkin et al. (U.S. Patent No. 6,584,564) in view of Lee et al. (U.S. Patent No. 6,661,877) in further view of Edmunds et al. (U.S. Patent No. 6,412,079).

13. In reference to claims 6,17,42,53,63 and 74 Olkin in view of Lee teach claim 1 and the above mentioned claims. Olkin fails to explicitly teach determining the subscriber profile attributes for the identified destination subscriber based on accessing a subscriber directory according to Lightweight Directory Access Protocol (LDAP), the subscriber profile attributes specifying the determined destination. However, Edmunds teaches accessing a directory according to the well known standard LDAP protocol within a unified messaging system (Abstract, column 8 lines 30-50 and column 10 lines 3-24).

It would have been obvious for one of ordinary skill in the art to modify Olkin by determining the recipient of the message by accessing a subscriber directory according to LDAP protocol for retrieval of destination information as per the teachings of Edmunds because LDAP is a well known standard facilitating directory searching.

14. In reference to claims 25 and 34, Olkin in view of Lee teach the above mentioned claims including the SMTP and IMAP protocols (see paragraphs 4 and 8). Olkin fails to explicitly teach accessing a subscriber directory according to Lightweight Directory Access Protocol (LDAP). However, Edmunds teaches accessing a directory according to the well known standard LDAP protocol within a unified messaging system (Abstract, column 8 lines 30-50 and column 10 lines 3-24).

It would have been obvious for one of ordinary skill in the art to modify Olkin by determining the recipient of the message by accessing a subscriber directory according to LDAP protocol for retrieval of destination information as per the teachings of Edmunds because LDAP is a well known standard facilitating directory searching.

Response to Arguments

15. Applicant's arguments with respect to claims 1-78 have been considered but are moot in view of the new ground(s) of rejection. Explanation of the claim rejections have been detailed above particularly addressing applicants concern, i.e. the user supplied encryption key.

16. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a message to be stored on a server) are not recited in the rejected claim(s). Although the claims are interpreted

in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that claim 1 specifies a message to be stored on a server, but nowhere in the claim does it indicate such a feature. Therefore the claim has also been rejected under 112 2nd paragraph because storing a message and leaving a message do not have the same meaning, and the limitaion of 'leaving a message' remains unclear.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M Osman whose telephone number is (703) 305-8050. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMO
October 14, 2004

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